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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,382	09/08/2000	Ronald G. Haagenstad	P4380	4990

7590 03/12/2004
Donald W Margolis
P O Box 20338
3445 Penrose Place Suite 225
Boulder, CO 80308

EXAMINER

BEACH, THOMAS A

ART UNIT PAPER NUMBER

3671

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/659,382

Applicant(s)

HAAGENSTAD, RONALD G.

Examiner

Thomas A Beach

Art Unit

3671

mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 9-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

The amendment filed proposes amendments to the claims (*claims added to the patent must be underlined in their entirety*) that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in a reissue applications. The examiners has underlined the added claims 9-12 in their entirety for the applicant only for the amendment filed

Claim Objections

2. Claim 9 and 11 are objected to because of the following informalities: it appears the preamble is set forth twice between lines 1-3 of claim 9, i.e. "combination (new) A tiered backhoe" and on line 7 of claim 11, the "\" after the period should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 9 is indefinite because it is unclear how the first and second couplers (24) are connected "adjacent a first end" and the second coupler "adjacent a second end" when it is only been shown that the couplers 24 are connected adjacent each other and at only one end of the plate, not two different ends. Claim 9 is further indefinite since that first tooth mount is claimed to be secured to the first end, which is the same end as the couplers (24) and it has only been disclosed and shown to be secured to the opposing end of the plate from the couplers. Claims 9 and 11 are indefinite because it is unclear how the first and second tooth mounts project in a "direction substantially orthogonal to said lateral edges" since the tooth mounts are shown in parallel with the lateral edges in figures 3-4 (orthogonal meaning related to or composed of right angles). Claim 11 is indefinite since it is unclear how the trenching plate 20 having a first and second portion that each include first, second and lateral side edges since only the plate as whole includes those edges and the portions (as best understood) do not include separate first, second, and lateral edges.

Claim Rejections - 35 USC 251

5. Claims 9-12 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ

Art Unit: 3671

289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 9,

line 4,

--having a transverse bend therein located between substantially planar first and second plate portions of said trenching plate and-- should be inserted after "plate".

line 6,

--oriented substantially parallel to the transverse bend-- should be inserted after "edge end".

Note that claim 11 would require proper antecedent basis with the plate portions.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3671

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-10 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark 3,724,899 in view of Hendricks 4,729,180. Clark shows a tiered trenching system with a bucket 30 having a trenching plate 58 with first, second, and side edges with a first coupler designed to be removably coupled to existing tooth shank 46 and a first tooth mounting means 67 is secured to the leading edge in a direction substantially orthogonal (figure 2) to that edge to create dual separated trenches (figure 7, 9, & 11); but does not show a second coupler and second tooth mounting means. However, Hendricks shows a similar a trenching system with a bucket 43 having a plurality of couplers, element 2 and 6, and a plurality tooth mounting means 20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Clark, as taught by Hendricks, to provide a second coupler to the existing teeth 46 and a second tooth mount in order to provide more (Hendricks col. 2, lines 51-60).

As concerns claim 10, the combination shows removable replaceable teeth are included (Hendricks col. 3, line 64).

Allowable Subject Matter

8. Claims 1-6 are allowed.

9. Claims 11-12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments with respect to claims 9-12 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments regarding Clark are noted; however, Clark clearly shows a tiered trenching system as shown in figures 7, 9, & 11. Furthermore, applicant has pointed out that element 43 is a sidewall which is true, the sidewalls of a bucket 30, thus meeting the claim language. Applicant's arguments regarding Hendricks are noted; however, arguments that an excavation bucket is not a backhoe are not persuasive or even relevant, since a backhoe is not being claimed but instead the preamble (as best understood due to the errors included in the preamble) sets forth a backhoe bucket which amounts to intended use which lack any patentable distinction from an excavation bucket. Furthermore, the claims set forth first and second teeth and not a "pair" as allegedly argued, in which the reference must show a first and second tooth, as noted above, and the fact that it shows ten teeth is irrelevant since a first and second tooth is included in the tenth tooth. Applicant's arguments regarding Hendricks as a 103(a) and non-analogous art are noted; however, the previous office action did not include a 103 rejection with Hendricks. The new grounds of rejection above includes Hendricks as a 103 in which where Hendricks certainly is analogous art where tiered trenching is a form of excavation and thus excavation and trenching are very relevant arts to one another since the function, the structures and classification of these arts is the same. A backhoe function is not even being claimed and more importantly would not be demonstrable as a patentable

Art Unit: 3671

structure or feature that would differentiate it from excavation, i.e. not patentably distinct from one another. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3671

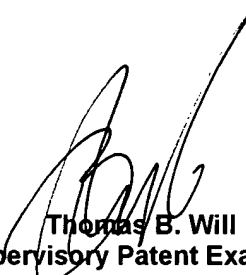
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A Beach whose telephone number is 703.305.4848. The examiner can normally be reached on Monday-Thursday, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 703.308.3870. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9306 or 703.872.9306 for regular communications and 703.872.9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.4198.

Thomas A. Beach

March 4, 2004


Thomas B. Will
Supervisory Patent Examiner
Group 3600